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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,744	12/02/2003	Larry C. Olsen	23-65037-01	6833
32215 7590 12/06/2010 KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET, SUITE 1600 ONE WORLD TRADE CENTER PORTLAND, OR 97204				
EXAMINER				
BARTON, JEFFREY THOMAS				
ART UNIT		PAPER NUMBER		
1728				
NOTIFICATION DATE		DELIVERY MODE		
12/06/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tanya.harding@klarquist.com

docketing@klarquist.com

erin.vaughn@klarquist.com

### Office Action Summary

**Application No.**

10/726,744

**Applicant(s)**

OLSEN ET AL.

**Examiner**

Jeffrey T. Barton

**Art Unit**

1728

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-18, 23-25 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-18 and 37-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date 20100901, 20101004
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The reply filed on 1 September 2010 does not place the application in condition for allowance.

***Status of Rejections Pending Since the Office Action of 3 March 2010***

2. All rejections are maintained.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 3, 5-10, 12-15, 17, 18, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Migowski (WO 89/07836; references below are made to the English translation of this document provided by Applicant) in view of Böttner. (21st Int'l Conf. on Thermoelectronics reference)

Regarding claims 1 and 37, Migowski discloses a thermoelectric power source comprising a flexible substrate having an upper surface (Page 3, 1st full paragraph); a plurality of thermoelectric couples, with the thermoelectric couples comprising: sputtered thin film p- and n-type thermoelements (1 and 2) as claimed (Paragraph bridging pages 2 and 3; Page 3, 1st full paragraph; Page 4, paragraph beginning with "Figure 1a . . .") and an electrically conductive member (3) positioned on the flexible substrate and connecting the p- and n-type thermoelements as claimed (Figure 2; Page 4, paragraph beginning with "Figure 1a . . ."); and wherein the thermoelectric couples are formed on a single substrate and rolled into a coil configuration. (Paragraph bridging pages 2 and 3)

Regarding claims 5 and 6, Migowski teaches 7500 thermocouples on a substrate, which produces 11 microwatts at 1.6V. (Page 4, paragraph beginning with "Layer thickness: . . .")

Regarding claims 13 and 39, Migowski teaches rolling a 30 cm long polyimide film (Paragraph bridging pages 2 and 3) having thermocouples with exemplary dimension of about 0.75 mm wide (Page 4, paragraph beginning with "Layer thickness: . . ." in conjunction with orientation of figure 2) Such a rolled-up device will clearly have volume less than 10 cm<sup>3</sup>. Migowski further teaches outputs of about 11 microwatts. (Page 4, paragraph beginning with "Layer thickness: . . .")

Regarding claim 15, Migowski teaches power output with a temperature difference of 6 °C. (Page 4, paragraph beginning with "Layer thickness: . . .")

Although Migowski suggests forming the thermocouples from known materials, including Bi, Sb, and Te (Page 3, 3rd full paragraph), he does not explicitly teach non-stoichiometric or co-sputtered compounds as claimed.

Böttner is cited as teaching co-sputtered non-stoichiometric thin films of n- and p-type bismuth/antimony telluride compounds as thermoelectric material used in forming thermocouples on a substrate. (Figures 11a and 11b, for example; "Growth of Thermoelectric Materials" section on page 514)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Migowski by specifically selecting the thin film bismuth/antimony tellurides or superlattice (Bi,Sb)<sub>2</sub>Te<sub>3</sub>/Sb<sub>2</sub>Te<sub>3</sub> as the thermoelectric materials, as taught by Böttner, because Migowski suggests forming the thermocouples

from bismuth, antimony and tellurium, and Böttner demonstrates the effectiveness of these materials as thermoelectric materials. The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

Regarding claims 3 and 17, Böttner suggests bismuth selenide materials for the thermoelectric devices (Conclusions and Growth of Thermoelectric Materials sections) in addition to the bismuth and antimony tellurides, and such choice of multiple known thermoelectric materials for the device would have been obvious to one having ordinary skill in the art. Note again that the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

Further regarding claims 5, 7-10, 14, and 38, the choice of a specific volume for the device, number of couples, and resulting power output are dependent on the specific application for the device. The specific wiring methods, series or parallel, also affects the power/current outputs for the device and are well known within the art to alter the wiring to meet the specific requirements of an application. Absent any unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose a specific volume, wiring method and output power as within the claims for the device of Migowski. The choice of element length, width, and thickness is known in the art to affect the power output available from a thin film thermocouple device, and is therefore considered to also be a design choice that is

obvious to one skilled in the art, absent any evidence of criticality or unexpected results. Therefore these claims are also obvious over the combination of art described above.

Regarding claims 12 and 18, Böttner teaches n- and p-type films comprising bismuth telluride and antimony telluride as claimed. (e.g. Figures 11a and 11b)

7. Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Migowski and Böttner as applied to claims 1, 3, 5-10, 12-15, 17, 18, and 37-39 above, and further in view of Bass et al. (US 6,207,887)

Migowski and Böttner are relied upon for the reasons given above.

Neither Migowski nor Böttner explicitly discloses a device with pluralities of thermoelements connected in series and parallel precisely as claimed.

Bass et al disclose a series-parallel connection scheme for a thermoelectric generator (Figure 13A; Column 6, lines 46-62) in which plural n-type elements are connected electrically in parallel and are connected in series to a plurality of p-type elements that are connected to each other in parallel.

It would have been obvious to one having ordinary skill in the art to further modify the device of Migowski by employing the series-parallel connection scheme of Bass et al, because Bass et al teach that such connection protects against complete power loss in the event of damage to a single thermoelement, thus providing increased reliability. (Column 6, lines 46-62)

***Response to Arguments and Affidavit under 37 CFR 1.132.***

8. Applicant's arguments and the declaration of Paul H. McClelland, both filed 1 September 2010 have been fully considered but they are not persuasive as they pertain to the rejections relying upon Migowski in view of Böttner.

The Examiner disagrees with applicant's arguments and Mr. McClelland's position as they pertain to what would be considered an enabling disclosure and what would be considered excessive or undue experimentation.

Böttner teaches cosputtering of non-stoichiometric thin films of n- and p-type bismuth/antimony telluride compounds as thermoelectric material used in forming thermocouples on a substrate as cited above. They teach that heated and cold substrates are used, and that the sputtering is done using elemental targets. Applicant and Mr. McClelland take the position that such disclosure is not enabling, since various parameters for the deposition are not specifically taught, such as substrate or annealing temperature, power applied to targets, atomic flux. The Examiner respectfully disagrees. As evidenced by the enclosed Mattox reference, it is conventional in the art to monitor, control, and vary (e.g. Sections 6.8-6.8.8) these and numerous other parameters in sputtering processes, and therefore it is the Examiner's position that it would have been within the abilities of one having ordinary skill in the art of sputter deposition to determine appropriate power levels, temperatures, atomic flux, etc in order to successfully deposit the films taught by Böttner. The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ



1165, 1174 (Int'l Trade Comm'n 1983), *aff 'd. sub nom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). Clearly the art of sputter deposition is routinely concerned with these variables, as evidenced by Mattox.

Regarding claim 3, Applicant argues that Böttner does not disclose or even contemplate a tertiary TE material. As cited above, Böttner suggests bismuth selenide materials for the thermoelectric devices (Conclusions and Growth of Thermoelectric Materials sections) in addition to the bismuth and antimony tellurides, and such choice of multiple known thermoelectric materials for the device would have been obvious to one having ordinary skill in the art. Note again that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). No rebuttal of this position, other than bare assertion that the teaching is not present is provided. Applicant appears to believe that the claim is limited to each listed material being present in each claimed thermoelement. There is no such limitation recited.

Regarding claim 5, Applicant argues that Migowski does not teach the instant power output. Again, as stated in the rejection, the choice of a specific volume for the device, number of couples, and resulting power output are dependent on the specific application for the device. The specific wiring methods, series or parallel, also affects the power/current outputs for the device and are well known within the art to alter the wiring to meet the specific requirements of an application. Absent any unexpected

results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose a specific volume, wiring method and output power as within the claims for the device

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey T. Barton whose telephone number is (571)272-1307. The examiner can normally be reached on M-F 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer K. Michener can be reached on (571) 272-1424. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey T. Barton/  
Primary Examiner, Art Unit 1728  
19 November 2010